

REMARKS

In the Final Official Action, the Examiner rejected claims 1-44. In the present response, Applicants have submitted a Declaration pursuant to 37 C.F.R. § 1.131 to remove the Derocher reference. Accordingly, Applicants respectfully request reconsideration of the present application in view of the remarks set forth below.

Rejection Under 35 U.S.C. § 112

In the Final Official Action, the Examiner rejected claims 6, 12, 19, and 44 under the same basis utilized in the previous Official Action mailed on December 31, 2003. Specifically, the Examiner rejected claims 6, 12, 19, and 44 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Further, the Examiner stated that the “specification fails to disclose any means, method or functional steps to obtain a quality factor for the speaker as claimed.” Again, Applicants respectfully traverse the Examiner’s rejection.

In the rejection, the Examiner asserted that the specification fails to disclose any means, method or functional steps to obtain a quality factor for a speaker. However, the Examiner again did not provide any support for this assertion nor did the Examiner cite to any case law in support of this assertion. Indeed, it appears that the Examiner has merely repeated the rejection from the previous Official Action. As such, Applicants wish to incorporate the remarks made in the previous Response to Official Action mailed on December 31, 2003. In view of these remarks, Applicants respectfully assert that the Examiner has not satisfied the evidentiary burden required by the binding precedents.

Furthermore, Applicants respectfully submit that the present application satisfies the test for enablement as set forth in M.P.E.P. § 2164.01. For example, the original claims recite a quality factor that is clearly supported in the specification. Specifically, claim 6 recites “wherein said transducer has a Q_{TS} in the range of 0.65 to 0.8,” while claims 12, 19 and 44 recite “wherein said driver has a Q_{TS} in the range of 0.65 to 0.8.” In the application, the quality factor Q_{TS} is described as a value of the driver at resonant frequency in free space. *See* Application, page 13, lines 29-30. The driver 120 is also described as having a quality factor Q_{TS} in the range of 0.65 to 0.8. *See* Application, page 15, lines 7-8. Clearly, the quality factor, which is defined in the present application, is one exemplary range for the driver 120 to operate within. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of claims 6, 12, 19 and 44.

Rejections Under 35 U.S.C. §§ 102 and 103

The Examiner rejected claims 1-2, 4-5, 8-11, 13, 16-17 and 22-23 under 35 U.S.C. § 102(b) as being anticipated by Derocher et al. (U.S. Patent No. 6,078,497), which is herein referred to as the Derocher reference. Further, the Examiner rejected claims 3, 14, 18, 24, 30-33, 35 and 37-38 under 35 U.S.C. § 103(a) as being unpatentable over Derocher in view of Sugimura (U.S. Patent No. 5,926,627), which is herein referred to as the Sugimura reference. The Examiner rejected claims 20-21, 25-29, 34 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Derocher in view of Sugimura and Koyama et al. (U.S. Patent No. 5,581,621), which is herein referred to as the Koyama reference. Also, the Examiner rejected claims 7, 15 and 39-43 under 35 U.S.C. § 103(a) as being unpatentable over Derocher in view of Sugimura and well-known prior art. Accordingly, because each of the rejections relies upon the Derocher reference, Applicants will address the rejections under Sections 102 and 103 together.

To utilize the Derocher reference for an anticipation or obviousness rejection under 35 U.S.C. §§ 102 and 103, the Derocher reference must qualify as prior art under 35 U.S.C. § 102, which specifically states:

A person shall be entitled to a patent unless —

...
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

...
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

The Examiner asserted that the Derocher reference qualifies as prior art under Section (b) of 35 U.S.C. § 102. However, because the Derocher reference was filed on January 29, 1999, and issued into a patent on June 20, 2000, the Derocher reference, on its face, fails to qualify as prior art under Section (b) of 35 U.S.C. § 102. That is, the Derocher reference does not satisfy the one-year requirement in Section (b) of 35 U.S.C. § 102 because the present application was filed on March 1, 1999, more than one year before the Derocher reference was published. Therefore, the Derocher reference could only possibly qualify as prior art against the present application under Section (e) of 35 U.S.C. § 102. Sections (a), (b), (c), (d), (f), and (g) of 35 U.S.C. § 102 simply do not apply in the present situation.

Because the Derocher reference could only possibly qualify as prior art only under 35 U.S.C. §§ 102(e)/103, a prior invention date may be established for the present application. Specifically, under 37 C.F.R. § 1.131, Applicants may overcome the Derocher reference by filing a declaration showing invention before the filing date of the Derocher reference. Under 37 C.F.R. § 1.131, the prior invention may be established in the United States, a NAFTA country, or a WTO member country. The showing should establish either (1) actual reduction to practice prior to the filing date of the Derocher reference, or (2) conception prior to the filing date of the Derocher reference coupled with diligence from prior to such date to a subsequent actual or constructive reduction to practice. It has long been held that conception may be established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor. *Brown v. Barton*, 41 U.S.P.Q. 99, 101-102 (C.C.P.A. 1939).

Enclosed with this Response to Final Official Action is a Declaration Pursuant to 37 C.F.R. § 1.131, which establishes that Applicants actually conceived the invention before the filing date of the Derocher patent and diligently worked toward a constructive reduction to practice. As required by 37 C.F.R. § 1.131(b), the accompanying Declaration establishes a conception prior to the effective date of the Derocher patent and due diligence from that date to the subsequent filing of the present application. In particular, the inventors, Mitchell Markow and David Gough, conceived of the invention prior to January 29, 1999, which is supported by a letter prepared by Robert Groover, a patent attorney, prior to January 29, 1999. 131 Decl., para. 4; Exh. A. On January 6, 1999, Robert Groover sent a draft of the application to the inventor, Mitchell Markow. 131 Decl., para. 5; Exh. B. The inventors reviewed the patent application and provided Mr. Groover with their comments. 131 Decl., para. 6; Exh. C. These revisions were incorporated into the patent application, and the revised application was transmitted to Mitchell Markow on February 17, 1999. *See id.* The

final application was forwarded to Diane Strong on February 26, 1999. 131 Decl., para. 7; Exh. D. Thus, Applicants were clearly diligent from prior to the filing date of the Derocher reference to the constructive reduction to practice, which is demonstrated by the filing of the present application on March 1, 1999, with the United States Patent and Trademark Office. Therefore, Applicants respectfully request that the Examiner remove the Derocher reference as prior art and withdraw all rejections based on the Derocher reference.

Furthermore, as discussed in the previous Response to Office Action mailed on December 31, 2003, which is hereby incorporated by reference, each of the other references fails to disclose the all of the claimed subject matter. Specifically, the Sugimura reference clearly discloses that the speaker unit 83 is mounted *externally* in the expander 2, not on the rear wall. As a result, one of ordinary skill in the art would not be inclined to add the speaker unit 83 internally to the rear wall of the docking station 20 because expanders coupled to the docking station 20 would cover the speakers. Also, regardless of whether the Koyama reference discloses an equalizer and gain staging, it does not cure the deficiencies of the Sugimura reference. As such, the Sugimura and Koyama references without the Derocher reference cannot possibly disclose the claimed subject matter.

Because the Examiner has failed to show that the cited references disclose or suggest the claimed subject matter, the Examiner has failed to establish a *prima facie* case of anticipation or obviousness. Therefore, Applicants respectfully request withdrawal of the rejections and allowance of independent claims 1, 10, 16, 24 and 39, and the claims depending therefrom.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request withdrawal of the Examiner's rejections and allowance of claims 1-44. If the Examiner believes

that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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